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27792 7	7590 11/22/2004	EXAMINER		
	CORPORATION	LEROUX, ETIENNE PIERRE		
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BELLEVUE,	WA 98004		2161	1.
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Please find below and/or attached an Office communication concerning this application or proceeding.

1,		Application	No	Applicant(s)			
		09/602,305		FISK ET AL.			
	Office Action Summary	Examiner		Art Unit			
	•						
	The MAILING DATE of this communication app	Etienne P Lo		2161			
Period for Reply							
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status							
1)⊠	Responsive to communication(s) filed on <u>02 A</u>	Jugust 2004					
2a)□		is action is n					
3)	,			secution as to the merits is			
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims							
4) Claim(s) 1-9, 11-14, 16, 18, 21, 22 and 27-41 is/are pending in the application.							
	4a) Of the above claim(s) is/are withdrawn from consideration.						
· <u> </u>	5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>1-9,11-14,16,18,21,22 and 27-41</u> is/are rejected.							
·	7) Claim(s) is/are objected to.						
	Claim(s) are subject to restriction and/or on Papers	r election req	juirement.				
	•						
·	The specification is objected to by the Examiner		r h) abjected to by th	o Eveminer			
10)⊠ The drawing(s) filed on <u>23 June 2000</u> is/are: a)⊠ accepted or b)□ objected to by the Examiner.							
11)[] -	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). 11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner.						
11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.							
12) The oath or declaration is objected to by the Examiner.							
Priority under 35 U.S.C. §§ 119 and 120							
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).							
a) All b) Some * c) None of:							
1. Certified copies of the priority documents have been received.							
	2. Certified copies of the priority documents have been received in Application No						
	3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.							
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).							
a) \square The translation of the foreign language provisional application has been received. 15) \square Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.							
Attachment(s)							
2) Notic	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) nation Disclosure Statement(s) (PTO-1449) Paper No(s)			(PTO-413) Paper No(s) atent Application (PTO-152)			

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Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/2/2004 has been entered.

Status of the Claims

Claims 1-9, 11-14, 16, 18, 21, 22 and 27-41 are pending. Claims 10, 15, 17, 19, 20, 23-26 are canceled. Claims 1-9, 11-14, 16, 18, 21, 22 and 27-41 are rejected in this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 11-14, 16, 18, 21, 22 and 27-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "accessing a genesis document." The scope of the invention cannot be determined because it is unclear what comprises a genesis document. For purposes of this Office Action "genesis document" will be given its broadest, reasonable interpretation and will be interpreted as a beginning or starting document.

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Claim 1 recites "performing a test search of a document source." The scope of the invention cannot be determined because it is unclear what comprises a "test search." For purposes of this Office Action, "test search" will be given its broadest reasonable interpretation and will be interpreted as initial search or first search.

Claim 1 recites "presenting the test search results to a user for a determination as to whether the test search results are desirable." The scope of the invention cannot be determined because it is unclear what comprises "test search results are desirable." For purposes of this examination, "desirable" will be given its broadest reasonable interpretation and will be interpreted as search results which are viewed by a user. 1

Claim 1 recites "embedding a search link corresponding to the search parameters into the genesis document." The scope of the invention cannot be determined because it is unclear what comprises a search link which corresponds to a plurality of search parameters. For purposes of this Office Action, "corresponding" will be given its broadest reasonable interpretation and will be interpreted as one or more of a plurality of search terms.

Claim 1 recites "test search results" and "search results." The scope of the invention is difficult to ascertain because the difference, if any, between test search results and search results is unclear. For purposes of this Office Action, examiner assumes that no difference exists between test search results and search results.

Claim 29 includes language similar to the above and is rejected for reasons similar to the above. Claims 2-9, 11-14, 16, 18, 21, 22, 27, 28 and 30-41 are rejected for being dependent from a rejected base claim.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-5, 7-9 13, 29, 31-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,347,943 issued to Fields et al (hereafter Fields) and further in view of US Pat No 5,222,234 issued to Wang et al (hereafter Wang), as best examiner is able to ascertain.

Claims 1 and 29:

Fields discloses accessing a genesis document [Fig 3, Fig 4, col 5, lines 33-45, page 1 is a genesis document because it is the beginning document] but fails to disclose performing a test search of a document source to identify test search results that satisfy a plurality of search parameters, in response to performing the test search, retrieving the test search results presenting the test search results to a user for a determination as to whether the test search results are desirable. Wang discloses performing a test search [Wang reads on "test search" because a database is examined for acceptable search results on a non-routine type basis, Fig 3, Fig 2, 48, col 4, lines 23-38, col 4, lines 45-55] of a document source to identify test search results that satisfy a plurality of search parameters, in response to performing the test search, retrieving the

¹ Applicant Preliminary Amendment and Request for Reconsideration, filed August 2, 2004 defines "presenting the test search results to a user for determination as to whether the test search results are desirable" in paragraph 1 of page 8,

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test search results, presenting [Fig 1, 10, col 4, lines 45-58] the test search results to a user for a determination as to whether the test search results are desirable [user has read all documents included in the search, therefore, the search results are acceptable, col 6, lines 37-40, furthermore, Fig 3A, col 5, lines 58-65 discloses the user is informed of successful completion of a search, thus results are desirable]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify fields to include performing a test search of a document source to identify test search results that satisfy a plurality of search parameters, in response to performing the test search, retrieving the test search results presenting the test search results to a user for a determination as to whether the test search results are desirable as taught by Wang for the purpose of finding information related to the subject matter of the document. The skilled artisan would have been motivated to improve the invention of Field per the above for the purpose of providing increased utility to a reader of the document by making information related to the document easily accessible to the reader.

Furthermore, Fields fails to disclose embedding a search link corresponding to the search parameters into the genesis document to create the embedded search link document, the search link operative, when activated to initiate a search of the document source for search results that match the search parameters and to retrieve the search results. Wang discloses embedding a search link in a document [search result document, col 7, lines 58-65]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fields to include embedding a search link in a genesis document for the purpose of saving the search parameters [col 1, lines 48-65]. The skilled artisan would have been motivated to improve the

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invention of Fields such that the user is able to quickly and accurately retrieve particular documents [col 1, lines 47-51].

Claims 3 and 31:

The combination of Fields and Wang disclose the elements of claim 1 as noted above. Furthermore, Fields discloses the embedded search link document comprises an interactive lesson plan [abstract]

Claims 4 and 32:

The combination of Fields and Wang disclose the elements of claim 1 as noted above.

Furthermore, Fields discloses the genesis document comprises a curriculum standards document [col 3, lines 50-60].

Claim 5:

The combination of Fields and Wang discloses the elements of claim 1 as noted above. Furthermore, Fields discloses a computer network [Fig 1].

Claims 7 and 35:

The combination of Fields and Wang discloses the elements of claim 1 as noted above. Furthermore, Fields discloses the steps of receiving filtered test search results, designating at least one of the filtered test search results as a preferred link, compressing and storing as a portion of the genesis document, a document identifier corresponding to the preferred link [bookmarking, col 5, lines 13-20].

Claims 8 and 33:

The combination of Fields and Wang discloses the elements of claim 1 as noted above. Furthermore, Fields discloses an Internet-accessible computer [col 3, lines 25-30].

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Claim 9:

The combination of Fields and Wang disclose the elements of claims 1 and 8 as noted above. Furthermore, Fields discloses wherein the step of accessing the genesis document comprises the step of retrieving the genesis document from a remote location [Fig 1].

Claim 13:

The combination of Fields and Wang discloses the elements of claim 1 as noted above. Furthermore, Fields discloses HTML-formatted documents [col 6, lines 9-21].

Claims 2 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fields and Wang and further in view of US Pat No 5,812,999 issued to Tateno, as best examiner is able to ascertain.

Claims 2 and 30:

The combination of Fields and Wang discloses the elements of claims 1 and 29 as noted above. The combination of Fields and Wang fails to disclose wherein a test search query based on the search parameters is formed for performing the test search of the document source further comprising compressing and storing the test search query as a portion of the genesis document so that activating the search link causes the test search query to be accessed and used for performing the search of the document source. Tateno discloses compressing the test search query [Fig 3, col 9, lines 237-40]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Fields and Wang to include compressing and storing the test search query as taught by Tateno for the purpose of efficiently searching and retrieving any of the stored words [col 1, lines 13-16]. The skilled artisan would have been

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motivated to improve the invention of the combination of Fields and Wang such that an efficient search can be made of an SGML-based document [col 1, lines 33-43].

1. Claims 6, 11, 16, 18, 34, 36, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fields and Wang and further in view of Pub No US 2001/0044833 issued to Eisendrath et al (hereafter Eisendrath), as best examiner is able to ascertain.

Claims 6, 34 and 36:

The combination of Fields and Wang discloses the elements of claim 1 as noted above. The combination of Fields and Wang fails to disclose a site catalog. Eisendrath '833 discloses a site catalog [paragraph 43]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Fields and Wang to include a site catalog as taught by Eisendrath '833. The ordinarily skilled artisan would have been motivated to modify the combination of Fields and Wang as above for the purpose of improving the invention by making it easier for a student to select course material

Claim 11:

The combination of Fields and Wang discloses the elements of claims 1 and 7 as noted above. Furthermore, the combination of Fields, Wang and Eisendrath discloses wherein the filtered test search results are stored as a site catalog [Eisendrath, paragraph 43], wherein the search link is operative, when activated, to initiate a search of the site catalog for the search results matching the search parameters [Wang, col 1, lines 47-51].

Claims 16 and 40:

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The combination of Fields and Wang discloses the elements of claim 1 as noted above. Furthermore, Fields discloses a student assessment page but does not disclose wherein the search parameters relate to a minimum grade level and a maximum grade level. Examiner notes that a minimum grade level and a maximum grade level are well-known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Fields and Wang to include a minimum grade level and a maximum grade level for the purpose of providing an overall indication of how well he/she performed when completing the assessment page.

Claim 18 and 41:

The combination of Fields and Wang discloses the elements of claims 1 and 16 as noted above. The combination of Fields and Wang discloses an electronic performance support system that is capable of providing for each user a customized course of instruction based on an assessment of each user's knowledge of a particular topic [col 1, lines 5-10] but fails to disclose wherein the subject comprises a pre-approved level one entry, the topic comprises a pre-approved level two entry, the minimum grade level comprises a first number ranging from 1 to 12 and the maximum grade level comprises a second number ranging from 1 to 12. Examiner maintains that minimum and maximum grade levels are well-known and expected in the art. The skilled artisan would have been motivated to improve the invention of Fields and Wang to include minimum and maximum grade level numbers for the purpose of providing a student with a quantitative assessment of requirements for successful completion of a course of instruction. Furthermore, the use of minimum and maximum grade level numbers assist with the entry of

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requirements in a computer because numbers can be easily entered in and retrieved from a computer.

2. Claims 12, 14 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fields and Wang and further in view of US Pat No 6,650,998 issued to Rutledge et al (hereafter Rutledge), as best examiner is able to ascertain.

Claims 12 and 37:

The combination of Fields and Wang discloses the elements of claim 1 as noted above. The combination of Fields and Wang fails to disclose filtering the search catalog to form a site catalog comprising those test search results that are most relevant to a particular context of the search parameters. Rutledge discloses filtering search results to form a catalog comprising those test search results that are most relevant to a particular context of the search parameters [col 1, lines 20-35]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Fields and Wang to include filtering search results to form a catalog comprising those test search results that are most relevant to a particular context of the search parameters for the purpose of excluding non-relevant information.

Furthermore, Wang discloses after creation of the embedded search link document, receiving a command for activating the search link and in response to the command, retrieving the search results from the site catalog [col 7, lines 52-57].

Claim 14:

The combination of Fields and Wang discloses the elements of claims 1 and 7 as noted above. Furthermore, Rutledge discloses filtering search results to form a catalog comprising

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those test search results that are most relevant to a particular context of the search parameters [col 1, lines 20-35]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Fields, Wang and Rutledge to include wherein the preferred link is placed first within the search results for the purpose of providing additional information related to the to the search result that has been ranked first.

3. Claims 21, 22, 27, 28, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fields and Wang and further in view of US Pat No 6,539,382 issued to Byrne et al (hereafter Byrne), as best examiner is able to ascertain.

The combination of Fields and Wang discloses the elements of claims 1 and 7 as noted above. The combination of Fields and Wang fails to disclose wherein a Boolean filter is used to determine the filtered test results. Byrne discloses wherein a Boolean filter is used to determine the filtered test search results [col 9, lines 13-19]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Fields and Wang to include wherein a Boolean filter is used to determine the filtered test search results as taught by Byrne for the purpose of pre-fetching and populating a cache with information expected to be needed by the user [abstract].

Claims 22 and 39:

Claims 21 and 38:

The combination of Fields, Wang and Byrne discloses the elements of claims 1, 7 and 21. Furthermore, Byrne discloses Boolean operators AND and NOT.

Claims 27 and 28:

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The combination of Fields and Wang discloses the elements of claim 1 as noted above. Furthermore, Fields discloses computer executable instructions [col 1, lines 36-59].

Response to Arguments

Applicant's arguments filed 8/2/2004 have been fully considered and found to be partially persuasive. Applicant requested a RCE and thus examiner has reconsidered the merits of the claimed invention. A rigorous investigation of the claimed invention is difficult, even after Applicant has amended the claims, because the claim language is overly broad, refer to above rejections under 35 U.S.C. 112, second paragraph. Applicant fails to particularly point out and distinctly claim the subject matter which Applicant regards as the invention by including words such as: (1) genesis document, (2) test search, (3) user determined desirable test search results, (4) test search results and (5) search results.

Nevertheless, examiner has carefully considered the amended claims in light of Applicant's comments filed August 2, 2004 and provides supra new art rejection. Supra new rejection makes Applicant's comments moot, however, applicant's most pertinent comments are discussed below.

Applicant Argument No. 1:

Applicant states in the fourth paragraph on page 7 "With regard to independent claim 1, applicant's recited claim language concerning the step of presenting the test search results to a user for a determination as to whether the test search results are desirable, is neither taught nor suggested by Hobbs. Applicants' claimed method first returns test search results for consideration by a user, and subsequently also returns search results when the search link

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embedded in the genesis document is activated. These two steps are not taught or suggested by Hobbs. In applicant's claimed method, a test search is initiated by depressing the test search button that instructs the search engine to search the site catalog for all documents meeting the parameters specified in the search criteria dialogue (see applicant's specification, page 22, lines 22-26). The site catalog is a compilation of all documents found by the search engine and determined, by the Boolean filter, to be relevant to potential search requests received from the search criteria dialogue (see applicant's specification, page 12, lines 16-19). Once all the relevant documents have been retrieved, the documents are presented to the user, and the user can thus see the 'results' that will be generated when a third party accesses a search link with parameters corresponding to those specified in the search criteria dialogue (see applicants' specification, page 22, lines 27-31). The user can also create a search link at this point (see applicants' specification, page 23, lines 5-6). Hence, these 'results' are test search results."

Examiner Response No 1:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., test search button, site catalog, search criteria dialogue, potential search requests, retrieval of relevant documents, Boolean filter, user can see the results, third party, create a search link at this point) are not recited in rejected claim 1 or 29. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, it is difficult to understand how "seeing" results is comparable to the claim

1 limitation which requires the user to determine whether the test search results are desirable.

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Furthermore, examiner is unable to follow above convoluted argument which attempts to show what comprises "results" and what comprises "test search results."

Applicant Argument No 2:

Applicant states in the second paragraph on page 8, "Later, users will access the 'newly created' search link, activating a search employing the same parameters originally specified by the link creator in the search criteria dialogue (see applicant's specification, page 26, lines 10-14). The results seen by a user in this later search may differ from the search results, because the site catalog is periodically updated. Updates may eliminate some documents or files, and add others. Thus, the specific documents can vary widely (see applicant's specification, page 26, lines 18-20). Hence these 'results' may be different and are referred to simply as 'search results' to distinguish them from the initial 'test search results.'"

Examiner Response No 2:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., newly created search link, activating a search employing the same parameters originally specified by the link creator in the search criteria dialogue, this later search, the search results, site catalog, periodically updated, the specific documents, these results, simple search results) are not recited in rejected claim 1 or 29. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Furthermore, examiner is unable to follow above convoluted argument which attempts to show what comprises: (1) these results, (2) simple search results and (3) initial test search results.

Applicant Argument No 3:

Applicant states in the third paragraph on page 8 "thus, two sets of results are returned using applicants' claimed method. A searchable document set is created (see applicants' specification, page 2, line 34) using the test search results as described above. For example, an administrator, may conduct the test search and create a search-enabled curriculum standards document for discovery and use by teachers (see applicants' specification, page 6, lines 20-21). Teachers are then able to retrieve the curriculum standards document that has been saved in HTML format and may specify a new search (see applicants' specification, page 8, lines 21-35).

Examiner's Response No 3:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., two sets of results, searchable document, an administrator may conduct the test search, search-enabled curriculum standards document, retrieve the curriculum standards document, HTML format, a new search) are not recited in rejected claim 1 or 29. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant Argument No 4:

Applicant states in the first paragraph on page 9 "Applicants' recited test search results are therefore very different from Hobbs' results shown in the frame, which are from expert pre-

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selected databases. Also, applicants' test search results are broken down into pages and are not equivalent to Hobb's results that are still in database form."

Examiner's Response No 4:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Hobbs' results in a frame, expert pre-selected databases, search results broken down into pages, results in database form) are not recited in rejected claims 1 or 29. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant Argument No 5:

Applicant states in the second paragraph on page 9 "Furthermore, applicants' claim 1 recites the step of: 'in response to the determination that the test search results are desirable, embedding a search link corresponding to the search parameters into the genesis document to create the embedded search link document, the search link being operative, when activated, to initiate a search of the document source for search results that match the search parameters and to retrieve the search results.' This step is neither taught nor suggested by Hobbs."

Examiner's Response No 5:

Examiner is partially persuaded. Examiner provides supra new art rejection over the combination of Fields and Wang which teaches above limitation which is interpreted to mean that a search criteria is stored in a document. This search criteria can be activated to search a document source and present the results of the search to a user.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Etienne LeRoux

11/19/2004.

SUPERVISORY PATENT EXAMINER

TECHNOLOGY CENTER 2100